

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL FAX CENTERApplication of: Storer *et al.*

Confirmation No.: 2201

JUL 02 2009

Serial No.: 10/608,907

Art Unit: 1623

Filed: June 27, 2003

Examiner: T. McIntosh III

For: MODIFIED 2' AND 3' NUCLEOSIDE
PRODRUGS FOR TREATING
FLAVIVIRIDAE INFECTIONSAttorney Docket No: 11874-055-999
(CAM: 417451-999055)
IDX 1018PETITION UNDER 37 C.F.R. § 1.182 TO WITHDRAW RECORDED TERMINAL
DISCLAIMER

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request withdrawal of the recorded Terminal Disclaimer filed on July 24, 2008. Applicants respectfully submit that since the above-captioned application has not issued, withdrawal of the recorded terminal disclaimer is proper. Manual of Patent Examining Procedure ("MPEP") § 1490 VII ("[i]f timely requested, a recorded terminal disclaimer may be withdrawn before the application in which it is filed issues as a patent...").

The Terminal Disclaimer filed on July 24, 2008 in the above-captioned application was filed in response to a provisional obviousness-type double patenting rejection over U.S. Patent Application No. 11/005,445 in the Office Action dated November 26, 2008. Because Applicants' amendment to the claims removed the only other rejection remaining in the Office Action, and U.S. Patent Application No. 11/005,445 has a filing date of December 6, 2004, the Terminal Disclaimer was unnecessary as the provisional obviousness-type double patenting rejection should have been withdrawn and the above-captioned application permitted to issue as a patent. See MPEP § 804, subsection I. B. (if provisional obviousness-type double patenting rejections are the only rejections remaining in an earlier filed pending application, the Examiner should withdraw those rejections and permit the earlier-filed application to issue as a patent without a Terminal Disclaimer). Thus, because the Terminal Disclaimer of July 24, 2008 was

LAI-3033989v1

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erroneously filed, withdrawal of the Terminal Disclaimer is proper. *See* MPEP § 1490, subsection VII. A. (there is no statutory prohibition against canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues).

A fee of \$400.00 is believed due pursuant to 37 C.F.R. §1.182 and 37 C.F.R. §1.17(f). Please charge this and any additional fees required to Jones Day Deposit Account No. 50-3013 (referencing 417451-999055).

Respectfully submitted,

Date: July 2, 2009


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